



1772
#8

September 19, 2003

Application Control Number 09/911,949
Applicant: Russo, Thomas Louis
Art Unit: 1772
Examiner: Patricia L. Nordmeyer

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SEP 30 2003

TC 1700

Dear Ms. Nordmeyer,

This letter is my understanding of your Advisory Action post marked July 1, 2003. I will attempt to complete your Advisory Actions points, by pasting your direction followed by my understanding.

Thank you in advance your help with my application.

Sincerely,

Thomas L. Russo

DETAILED ACTION

Continuation of #2: Applicant has amended independent claims 1 and 4 by adding proposed new limitations "valve less" which require a new search and or further consideration.

ENTRY NOT

It should be kept in mind that applicant can rejected claims, add new claims after a final previously canceled claims.

Except where an amendment merely cancels removes issues for appeal, or in some other examiner, compliance with the requirements expected in all amendments after final rejection 1.113 to the final rejection results in abandonment to:

- (A) an amendment complying with
- (B) a Notice of Appeal (and appeal)
- (C) a request for continued examination submission (i.e., an amendment that meets 1.111) and the fee set forth in 37 CFR 1.114 does not apply to utility or plant patent 1995 and design applications.

Continuation of #5: The application is not Applicant's arguments are drawn to a proper Thus, the arguments are not commensurate applicant's arguments are drawn to the limit Therefore, the arguments are moot as they

record. Applicant's arguments of record are not found persuasive because they rely on the non-

Response:

The use of the words valve less was to help clarify my claims as you suggested in your office action of March 22 2003. The words valve less was an attempt to categorize the type of inflatable system used. Valve less inflatable verses valved inflatable. For example current void fill pads used commercially today have no valves such as the inflatable air cushions mentioned in the "background of invention" section in my application as opposed to the valved air cushions also mentioned in the background of inventions. I was trying to clarify as you requested that this was one of the valve less types. The valve less category already exists in today's packing programs. Every thing from bulb wrap to air cushion pillows.

I would have hoped that after reviewing all of the parts of my application, summary of invention, brief description of drawings, detailed description of invention, and my abstract, that it would have been obvious that this is of the valve less inflatable type. There is no valve because the pad is inflated when it is produced; it only has an exit and entry portal tube that is cut open if you plan to reuse the air pad. That is why it did not appear in my original claims that you rejected, because it was not clear why my invention was different than Mr. Jaszai and Mr. Magid inventions.

Removing the words valve less from my claims will not alter the effectiveness of my invention. Anyone producing this pad would certainly realize there are no valves to be installed.

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entered amendments. Applicant is referred back to the final rejection of record in Paper #5, mailed on March 19, 2003.

Applicant is asked to read the following section (b) from the *Manual of Patent Examination Procedures* regarding the 37 CFR 1.116 regulations when amending claims after final rejection. Applicant's amendment to the claims has not been entered and prosecution has been closed on the case after the final rejection filed on March 19, 2003. The amendment to the claims changes the claimed structure of the invention, which would require a new search for prior art which reads upon the structure claimed in the new claims.

§ 1.116 Amendments after final action

(a) An amendment after final action or a section.

(b) After a final rejection or other final action, a reexamination filed under § 1.510, or

1.949) in an inter partes reexamination file

made canceling claims or complying with the provisions set forth in a previous Office action. Amendment for consideration on appeal may be admitted, any amendment after a final rejection, prosecution, or any related proceedings will not remove the application from its course under reexamination from its course under the application from abandonment under § 1.116. No amendment can be made in a proceeding after the right of appeal notice is given in paragraph (d) of this section.

(c) If amendments touching the merits of a reexamination are presented after final rejection or when such amendment might not otherwise be presented upon a showing of good and sufficient reason not earlier presented.

Response:

So basically what you are saying here is because you did not understand that from the beginning that this is and always was an infallible pad system without valves. And now that I stated what was obvious to anyone who understands the art of producing and developing inflatable packing systems to clarify your request, my application requires a new search.

It seems as though I am paying a penalty for you not understanding the invention. How do you explain that and where in your amendments, and appeals, and matter of right, etc., etc. is that reflected in your advisory or office action.

If you had understood it from the beginning you would have never suggested that it was the same as Mr. Jaszai and Mr. Magid. Now that you have done that you can not retreat, can you? Lets blame the applicant he is adding new information. Look you were wrong to suggest that my invention was the same as Mr. Jaszai and Mr. Magid, they were not even designed for the same purpose, but you tried to squeeze it into some configuration that suggest it was the same. Shame on you... admit these are not the same, and lets move on. Most applicant do not want to steal someone else's invention. If there is an invention that is the same as mine and it is prior to mine then that is great, commerce can use this type of product for all the reasons mentioned in the Background of invention section. I do not want to infringe on someone else's invention.... How can you help me with this issue?

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(d) No amendment can be made as a matter of right in appealed cases. After decision on appeal, amendments can only be made as provided in §§ 1.198 and 1.981, or to carry into effect a recommendation under § 1.196 or § 1.977.

Regarding section (a) of 37 CFR 1.116, the amendments must comply with 37 CFR

1.114. As explained in section (b), the amendments must place the rejected claims in better form for consideration in order to be entered. The amendments presented in the reply fail to meet this criteria. Nor, do the amendments or the arguments show sufficient reasons as to why the amendments were necessary and not presented earlier in the prosecution, section (c). Section (d) is not applicable at this present time.

An examination of this application reveals a prosecution procedure as the arguments presented towards limitations which are contained in the claims are not clearly stated in the specification. When a person of skill in this field usually acts as a liability in an invention disclosed. Applicant is advised to select an agent to prosecute the application, since the value of preparation and prosecution. The Office cannot

Applicant is advised of the availability of Registered to Practice Before the U.S. Patent and Trademark Office by the Superintendent of Documents, U.S. Government Printing Office, Washington, DC 20402.

Response:

You are right I don't understand the proper phrasing, and legal confusion necessary to get an application approved. I am just an everyday person with an idea.

Your suggestion to retain a patent attorney, to help the PTO process my application is appreciated but not possible.

The average patent could cost between \$10,000 to \$20,000, just to get it to this point. Even if it was only \$5000, it still puts patenting ideas outside of the reach of most of our nation's citizens. For the sake of PTO process we are making patent protection available only for the rich and industry applicants. It seems unbelievable that I have to hire an attorney to intervene through the patent application process to work with a government agency that I already pay for either directly or indirectly. Does that seem right to you, when I wouldn't need an attorney at all, if the examiner's direction was to instruct me on how to get my application approved, rather than why it can't be approved.

I know this issue is above your job scope, but you did the right thing by suggesting I get an attorney, to protect any repercussions that may occur between the PTO and a home inventor applicant.

I need your help as my examiner, how do I need to arrange my words to meet your needs?

The specification of the applicant should clearly state and include all of the limitations and embodiments of the claimed invention in order for the patentability of the invention to be determined by the Examiner. It may be in the best interest of the Applicant to file a continuation or continuation-in-part of the invention where the structure of the article is clearly disclosed and claimed, both in the article's initial use and in its reusable state.

Any inquiry concerning this communication should be directed to Patricia L. Nordmeyer, Examiner, Art Unit 1772. The examiner can normally be reached on Fridays.

If attempts to reach the examiner by telephone, supervisor, Harold Y. Pyon can be reached on the telephone at the organization where this application or proceeding is pending, communications and (703) 872-9311 for After Hours.

Any inquiry of a general nature or relating to the status of this application should be directed to the receptionist whose telephone number is listed on the first page of the application.

Patricia L. Nordmeyer
Examiner
Art Unit 1772

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June 26, 2003

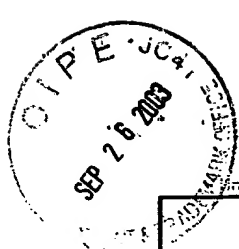
Response:

If you are speaking of the words valve less it is neither a limitation or a select embodiment. It is a commercial category of an inflatable item. My invention has no valves and is classified in that group. Anyone reading my application, even with a cursory knowledge of the art of inflatable packing materials would understand there is no valve. I stated valve less because you directly compared my invention to Mr. Jaszai and Mr. Magid, and the most obvious difference was that they are of the valved inflatable class and my was valve less, this was one of several differences, between my invention and theirs. The words valve less is not necessary because there is no mention of valves in the description of my invention, or any other sections of my application that presents my invention.

Inquiry about this application is very difficult because of my job requirements, I am not available from 6:30AM to 6 or 7 PM Monday through Friday. If we can pre arrange a lunch time call I will try and have the necessary information at work so we can communicate by phone.

I still believe this application, and all its office actions and advisory actions and my responses should be reviewed by your internal committees that are charged with improving the PTO's interface with Home Inventors. This might help you in your position, and other applicants like myself.

I am sorry if my frustration is apparent in this response.



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